UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,501	03/07/2002	Vladimir Kliatzkin	P-2684-US	7024

27130 7590 06/17/2004

EITAN, PEARL, LATZER & COHEN ZEDEK LLP
10 ROCKEFELLER PLAZA, SUITE 1001
NEW YORK, NY 10020

EXAMINER	
ALEJANDRO, RAYMOND	

ART UNIT	PAPER NUMBER
1745	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/070,501	KLIATZKIN, VLADIMIR	
	Examiner	Art Unit	
	Raymond Alejandro	1745	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office communication is in response to the amendment filed 03/25/04. The applicant has overcome most of the objections, the 35 USC 112 rejection and the 35 USC 102 rejection over Erez et al'742. Refer to the abovementioned amendment for specific details on applicant's rebuttal arguments. However, the claims are finally rejected over art as seen below and for the reasons of record:

Election/Restrictions

1. Newly submitted claim 27 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 27 is drawn to a rechargeable battery cell comprising a single cell per se classified in class 429/127 while the originally presented claims are directed to electrochemical battery cells including a plurality of cells (two or more units) in electrical connection classified in class 429/149. Thus, claim 27 is drawn to a separate and distinct invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 27 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Oath/Declaration

2. The oath or declaration is ***still*** defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not state that the person making the oath or declaration believes the named inventor or inventors to be ***the first*** inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Drawings

3. The drawings were received on 03/25/04. These drawings are acceptable.

Specification

4. The substitute specification filed 03/25/04 has been entered and made of record.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

(claim 4) the active material being Ni/Cd;

(claim 6) the specific electrode thickness range;

(claim 7) the specific grain size of 1-5 micron (it is noted that the specification only provides support for ranges between 5-10 micron);

(claim 17) the specific anode or cathode grid;

(claim 20) the specific coating as applied to the anode/cathode;

(claim 24) the specific separator structure consisting of three different layers;

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Language Suggestions

7. Claims 2, 23 and 24-25: it is suggested to replace the term "*executed*" with any other suitable terminology so as to have a better understanding of the scope of the invention. Appropriate correction is required.

8. Claims 2 (line 9), 7 (line 2) and 17 (line 1): it is suggested to replace the term "*suitable*" with any other terminology so as to have a better understanding of the scope of the invention. Appropriate correction is required.

9. Claim 13: it is suggested to delete the phrase "*such as*" so as to have a better understanding of the scope of the invention. Appropriate correction is required.

10. Claim 15 and 20: it is suggested to replace the term "*used*" with any other suitable terminology such as "applied" and the like so as to have a better understanding of the scope of the invention. Appropriate correction is required.

11. Claim 23: it is suggested to delete the term "*type*" so as to have a better understanding of the scope of the invention. Appropriate correction is required.

Claim Objections

12. Claims 1 and 16 are objected to because of the following informalities: the parenthesis notation should be deleted so as to better reflect the intended scope of the claim. Appropriate correction is required.

13. Claim 1 recites the limitation "the active material" in line 3. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 3: the phrase "*other active material fibers*" should be replaced with specific active materials so as to have a better understanding of the scope of the invention. Appropriate correction is required.

15. Claim 3 recites the limitation "the electrode fabric" in line 1. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 5 recites the limitation "the support" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

17. Claim 7 recites the limitation "the particles" in line 1-2. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 8 recites the limitation "the fabric" in line 2. There is insufficient antecedent basis for this limitation in the claim.

19. Claim 9 recites the limitation "the assembly" in line 3. There is insufficient antecedent basis for this limitation in the claim.

20. Claims 11-12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

claim(s) in independent form. It is noted that the preamble and body claim of claims 11-12 are not consistent with the preamble and subject matter of the claim from which they both depend from.

21. Claim 16 recites the limitation "the bulk active material" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

22. Claim 22 recites the limitation "the outer container" in line 2. There is insufficient antecedent basis for this limitation in the claim.

23. Claim 24 recites the limitation "the separator" in line 2. There is insufficient antecedent basis for this limitation in the claim.

24. Claim 23: the phrase "*other method*" should be deleted or at least replaced with specific techniques so as to have a better understanding of the scope of the invention. Appropriate correction is required.

25. Claim 26 is objected as being in improper form because it has been drafted to depend twice from claim 25 (in two different ways).

Claim Rejections - 35 USC § 112

26. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

27. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

28. Claims 11-12 are indefinite as they preamble and body claim are not consistent with the preamble and subject matter of the independent claim from which they both depend, directly or indirectly.

***Note:* to the extent the present claims were understood by examiner, please note the following art rejections. In this regard, it is noted that the claimed subject matter combines together multiple and distinct battery and fuel cell environments, components and features. Accordingly, for purpose of rejection, the examiner has also employed and applied several references specifically addressing the individually detailed subject matter as instantly claimed.**

Claim Rejections - 35 USC § 102

29. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

30. Claims 1-3, 10 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Honda et al 5580676.

The present application is directed to a battery cell wherein the disclosed inventive concept comprises the specific unit configuration.

With respect to claims 1-3:

Honda et al disclose a rectangular battery including a plurality of cathode plates and anode plates alternately superposed via a separator to face each other. The cathode plates and the anode plates are consecutively packed with the separator and being folded at a separator fusing portion between the plates (ABSTRACT). It is disclosed that the anode plate is formed by a copper foil having both or one side thereof coated with a mixed anode agent; the separator is composed of a polymeric material and the rectangular battery has at least the cathode plates or the anode plates respectively packed with the separator, intrusion of the powder of the cathode plate and the anode plate into each other is prevented (COL 2, lines 25-38). It is disclosed that the layered product formed by the electrode plates and the separator is inserted into a rectangular battery casing and then a liquid electrolyte is filled therein (COL 1, lines 15-20). It is disclosed the electrode are enveloped by or packed between the separators and the packed electrode plates being folded at the separator fusing portion (COL 1, lines 60-67).

Figures 18 and 20 below illustrate battery embodiments

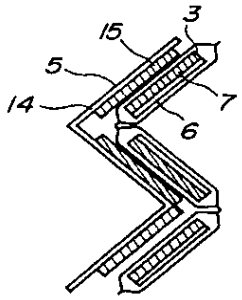

FIG.18

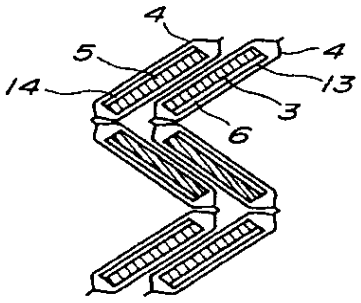

FIG.20

Examiner's note: *the claim language "means being provided for maintaining pressure from granule to granule and from granule to electrode flexible frame for needed electrical contact)" has not been construed as invoking the 35 USC 112, 6th paragraph because it does not meet, at least, two of the 3-prong analysis conditions due to the over-modified structure for achieving the specified function (See MPEP 2181). That is, a) the claim limitations does not strictly use the phrase "means for" (i.e. the claim recites "means being provided for") and b) the phrase "means for" must not be modified by sufficient structure, material or acts for achieving the specified function as instantly claimed.*

As for claim 10:

Honda et al disclose that the separator is formed of a porous polymeric material having holes, submicron to several micro diameter, opened therein for passing ions wherein the it is a sheet-like film of polypropylene or polyethylene (COL 4, lines 7-12).

Regarding claim 22:

It is noted that the battery enclosure itself of Honda et al imparts the necessary pressure and elasticity to ensure adequate electrical contact therein. *Thus, this function is inherent to the battery assembly per se.*

Thus, the claims are anticipated.

Claim Rejections - 35 USC § 103

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

32. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

33. Claims 3, 5-6, 8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al 5580676 as applied to claim 1 above, and further in view of Schulze et al 5993618.

Honda et al are applied, argued and incorporated herein for the reasons above. However, Honda et al do not expressly disclose the specific flexible fabric electrode support and its thickness.

Schulze et al disclose an electrochemical cell in which a gas-diffusion electrode is provided as porous cathode wherein the carrier material is planar woven carbon fiber fabric

(COL 7, lines 14-25). It is also disclosed that finished electrode is catalyzed (COL 7, lines 15-25). It is also disclosed that the fabric thickness is of 0.36 mm or 0.4-0.5 mm for a finished electrode (COL 7, lines 14-25). *Thus, the finished catalyzed electrode has a layer thickness ranging from 0.04-0.14 mm.*

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific flexible fabric electrode support of Schulze et al in the battery of Honda et al as Schulze et al disclose that such fabric electrode supports as well as the finished catalyzed electrode provide sufficient mechanical stability and structural integrity so as to be used in electrode applications.

As to the specific thickness, it would have been obvious to a skilled artisan at the time the invention was made to make Honda et al' electrode by having the claimed thickness because even though Schulze et al's electrode thickness does not overlap or lie inside the claimed thickness a prima facie case of obviousness exist where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metal Corp. of America v. Banner 227 USPQ 773.* Moreover, the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine a satisfactory and optimum thickness.

34. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al 5580676 as applied to claim 1 above, and further in view of Aihara et al 2003/0170536.

Honda et al are applied, argued and incorporated herein for the reasons above. However, Honda et al do not expressly disclose the specific pair of active material.

Aihara et al disclose batteries such as silver-zinc batteries as well as nickel-cadmium batteries (SECTION 0048).

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific pair of active material of Aihara et al in the battery of Honda et al because Aihara et al disclose that, generally, batteries' teachings are especially effective and not limiting to specific applications, that is to say, batteries' teachings are applicable to either primary batteries such as silver-zinc batteries as well as other type of batteries such as nickel-cadmium batteries. Thus, Aihara et al envision the interchangeability of specific battery applications, components and teachings regardless of the particular battery chemistry.

35. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al 5580676 in view of Schulze et al 5993618 as applied to claim 1 and 6 above, and further in view of Takamura et al 4407907.

Honda et al and Schulze et al are applied, argued and incorporated herein for the reasons above. However, Honda et al do not expressly disclose the specific grain/particle size.

Takamura et al disclose an electrode bodies comprising sintered powder material having a particle size of from 0.2-40 μm (COL 1, line 20-30).

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific grain/particle size of Takamura et al in the battery of Honda et al and Schulze et al as Takamura et al disclose that in electrodes have been common to use sintered powder material having the claimed particle size as it provides electrode structures

having effective interface for discharge reactions and thus possible to obtain a large current generation.

36. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al 5580676 as applied to claim 1 above, and further in view of Pyszczel et al 5756229.

Honda et al are applied, argued and incorporated herein for the reasons above. However, Honda et al do not expressly disclose the specific helical/spiral configuration.

Pyszczel et al disclose a spirally-wound electrochemical cell having a resilient member such as a spring disposed between the spirally wound electrode and separator assembly (ABSTRACT).

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific helical/spiral configuration of Takamura et al in the battery of Honda et al as Takamura et al divulge that such specific helical/spiral configuration allows to effectively dissipate mechanical forces acting to otherwise cause axial movements of the electrode assembly. Thus, it enhances mechanical stability of the battery assembly.

37. Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al 5580676 as applied to claim 1 above, and further in view of Takamura et al 4407907.

Honda et al are applied, argued and incorporated herein for the reasons above. However, Honda et al do not expressly disclose the specific carbon fiber associated to the silver.

Takamura et al disclose an electrode body formed by integrating carbon powder carrying a catalyst such as silver (COL 1, lines 48-55).

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific carbon fiber associated to the silver of Takamura et al in the battery of Honda et al as Takamura et al disclose that electrode bodies integrating the claimed material have a low oxygen reduction over-voltage.

38. Claims 14-15, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al 5580676 as applied to claim 1 above, and further in view of Faris et al 2003/0143446.

Honda et al are applied, argued and incorporated herein for the reasons above. However, Honda et al do not expressly disclose the specific active material porosity, and the specific metal coating.

Faris et al disclose electrochemical cell system wherein the anode and the cathode have a particular degree of porosity e.g. 50 % (SECTION 0172, 0185-0186).

As to the method limitation, i.e. the specific preliminary pressing or pressure, and sintering and/or pressing technique, it is noted that a method limitation incorporated into a product claim does not patentable distinguish the product because what is given patentably consideration is the product itself and not the manner in which the product was made. Therefore, the patentability of a product is independent of how it was made.

Faris et al also disclose applying a thin metal layer of about 1-10 microns (SECTIONS 0185-0187).

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific active material porosity of Faris et al in the battery of

Honda et al as Faris et al disclose that such porosity allow ions within the ionically conducting medium to flow with minimum electrical resistance between the required current collecting elements of the anode and cathode structures.

As to the specific metal coating, it would have been obvious to one skilled in the art at the time the invention was made to use the specific metal coating of Faris et al in the battery of Honda et al as Faris et al disclose that the function of the thin metal layer is to provide efficient current collection at the anode surface.

39. Claims 16-17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al 5580676 as applied to claim 1 above, and further in view of Hampden-Smith et al 6689186.

Honda et al are applied, argued and incorporated herein for the reasons above. However, Honda et al do not expressly disclose the specific grid body and material; and the separator structure.

Hampden-Smith et al disclose electrode bodies being made as grid wherein the anode grid made of zinc, and the cathode grid using silver (COL 52, lines 15-35).

Hampden-Smith et al also disclose an electrochemical cell comprising a plurality of separator layers (COL 52, lines 8-20).

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific grid body and material of Hampden-Smith et al in the battery of Honda et al as Hampden-Smith et al disclose that the claimed grid body and material are suitable for use in preparing storage batteries; additionally, it is taught that anodes/cathode

are typically made of specific material and structures. Thus, Hampden-Smith et al directly teach the use of the specific grid electrode body and material.

As far as the separator structure, it would have been obvious to one skilled in the art at the time the invention was made to use the separator structure of Hampden-Smith et al in the battery of Honda et al as Hampden-Smith et al disclose that such separator structure acts as a semi-permeable membrane assuring adequate contact of the anode and cathode with the electrolyte.

40. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al 5580676 in view of Takamura et al 4407907 as applied to claim 18 above, and further in view of Faris et al 2003/0143446.

Honda et al and Takamura et al are applied, argued and incorporated herein for the reasons above. However, Honda et al do not expressly disclose the specific anode metal coating and layer porosity.

Faris et al disclose thin metal layers applied to the anode surface including also zinc powder applied as a coating upon the surface thin metal layer, the zinc layer having a porosity of about 50 %.

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific anode metal coating of Faris et al in the battery of Honda et al and Takamura et al as Faris et al disclose that the function of the thin metal layer is to provide efficient current collection at the anode surface.

As to the specific layer porosity, it would have been obvious to one skilled in the art at the time the invention was made to use the layer porosity of Faris et al in the battery of Honda et al and Takamura et al as Faris et al disclose that such porosity allow ions within the ionically conducting medium to flow with minimum electrical resistance between the required current collecting elements of the anode and cathode structures.

41. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al in view of Faris et al 2003/01434465580676 as applied to claim 25 above, and further in view of Aihara et al 2003/0170536.

Honda et al and Faris et al are applied, argued and incorporated herein for the reasons above. However, Honda et al and Faris et al do not expressly disclose the specific silver active material electrode.

Aihara et al disclose batteries such as silver-zinc batteries as well as nickel-cadmium batteries (SECTION 0048).

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific pair of active material of Aihara et al in the battery of both Honda et al and Faris et al because Aihara et al disclose that, generally, batteries' teachings are especially effective and not limiting to specific applications, that is to say, batteries' teachings are applicable to either primary batteries such as silver-zinc batteries as well as other type of batteries such as nickel-cadmium batteries. Thus, Aihara et al envision the interchangeability of specific battery applications, components and teachings regardless of the particular battery chemistry.

Response to Arguments

42. Applicant's arguments filed 03/25/04 have been fully considered but they are not persuasive. Since applicant has overcome the art rejection over Erez et al'742, the examiner will only address applicant's arguments with respect to the art rejection over Honda et al'676.

With respect to the assertion that the cited reference does not teach the means for maintaining pressure, it is noted that, in overall, the claim language "means being provided for maintaining pressure from granule to granule and from granule to electrode flexible frame for needed electrical contact)" has *not* been construed as invoking the 35 USC 112, 6th paragraph because it does not meet, at least, two of the 3-prong analysis conditions due to the over-modified structure for achieving the specified function (See MPEP 2181). That is, a) the claim limitations does not strictly use the phrase "means for" (i.e. the claim recites "means being provided for") and b) the phrase "means for" must not be modified by sufficient structure, material or acts for achieving the specified function as instantly claimed. Thus, given that the claim language fails to adequately invoke such mean-plus function, and in the absence of specific structural features further defining the pressure maintaining means, it is contended that at least the battery enclosure itself or the separator of the prior art exerts sufficient pressure in the battery assembly so as to provided the necessary electrical contact.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*embodiments of the present application are intended...to deal with short circuits induced by dendrites*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that "*Honda purports to disclose a solution to the problem of crumpling of the separator*", the fact that applicant has recognized another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

43. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

44. In addition, applicant's amendment necessitated the new ground(s) of rejection presented in this Office action for claims 4-10 and 13-26. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Alejandro whose telephone number is (571) 272-1282. The examiner can normally be reached on Monday-Thursday (8:00 am - 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond Alejandro
Examiner
Art Unit 1745